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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,683	07/19/2005	Kouji Miura	2005_1138A	9315

52349 7590 11/12/2009

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EXAMINER	
NILFOROUSH, MOHAMMAD A	
ART UNIT	PAPER NUMBER
3685	

MAIL DATE	DELIVERY MODE
11/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/542,683	MIURA ET AL.	
	Examiner	Art Unit	
	Mohammad A. Nilforoush	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *61,64,70 and 73* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *61, 64, 70, and 73* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. The amendment filed 29 July 2009 is acknowledged.

2. Claims 61, 64, 70, and 73 are pending.

3. Claims 61, 64, 70, and 73 have been examined.

4. This Office action is given Paper No. 20091018 for reference purposes only.

Response to Amendment/Arguments

5. Applicant's claims have been amended to recite conditional language that does not serve to differentiate the claims from the prior art. Claim 61 recites "...a sending unit that, *when successive transaction processes of the plurality of transaction processes are processed*, sends a plurality of request messages..." and "...a response receiving unit that, *when the successive transaction processes of the plurality of transaction processes are processed*, receives a plurality of response messages from the server device..." Thus, sending and receiving a plurality of request messages is conditional on the successive transaction processes being processed. Claims 70 and 73 recite language that is similarly conditional. ..." MPEP §2106 II C states that language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Further, with regard to the method claim, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally performed under certain other hypothetical scenarios. (*In re Johnston*, 77

USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C).

6. The amendment of claims 61 and 73 overcomes the rejection of claims 61, 64, and 73 under 35 USC §101. However, the amendment of claim 61 renders the software "units" nonfunctional descriptive material as they are not functionally related to the system by being stored in a memory and executed by the processor. Similarly, the amendment of claim 73 renders the program recorded on the medium nonfunctional descriptive material as the claim does not require that the program be executed to cause a processor to perform certain actions. It has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

7. The amendment of claim 70 is insufficient to overcome the rejection of that claim under 35 USC §101. Although the claim has been amended to add recitations of a "terminal device" and a "server device", the method steps are not sufficiently tied to a particular apparatus as each step is not tied to the particular apparatus that performs it. Further, the tie to a particular apparatus must be more than extra-solution activity. In order to achieve this, each method step should recite the particular apparatus that performs it. For example, "...storing, by the terminal device...sending, by the terminal

device...receiving, by the terminal device...generating, by the terminal device...generating, by the terminal device...updating, by the terminal device, performing, by the terminal device...and sending, by the terminal device..."

8. Examiner additionally notes that the language "...wherein the program causes a computer in the terminal device to *function as*..." is unclear as the term "function as" can be interpreted to mean that the computer in the terminal device performs the explicit functions of the claimed units, acts in a manner equivalent to the function performed by the units, or only acts similarly to the units.

9. The amendment of claims 61, 70, and 73 overcomes the previous rejections of claims 61, 64, 70, and 73 under 35 USC §112, second paragraph.

10. Applicant's remaining arguments with respect to claims 61, 64, 70, and 73 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claim 70 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

13. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class

(such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 70 fails prong (1) because the "tie" (e.g. "terminal device" and "server device") is representative of extra-solution activity as each step is not tied to the particular apparatus that performs it. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 61, 64, and 70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Claim 61 makes reference to multiple statutory classes of invention. Claim 61 is directed towards “a terminal device”. However, the claim recites method steps performed by the device, such as, "...wherein, when said response receiving unit receives a response message form the server device without an occurrence of a communication error, said sending unit sends...” A claim that purports to be within multiple statutory classes is ambiguous and is properly rejected under U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the invention (*Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

Claim 64 is rejected as it depends on claim 61.

17. Claim 61 is also rejected as the scope of the claim is unclear. Claim 61 is directed towards "a terminal device”. However, the claims recite a processor with components comprised of software "units". Thus, it is unclear to one of ordinary skill what structural elements are claimed. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claim 64 is rejected as it depends on claim 61.

18. Claim 70 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the

steps. See MPEP § 2172.01. The omitted steps are: processing successive transaction processes of the plurality of transaction processes. Claim 70 recites "...sending a plurality of request messages...when successive transaction processes...*are processed*..." as well as "...receiving a plurality of response messages...when the successive transaction processes *are processed*." However, there is no previous positively recited step of processing the successive transaction processes. Thus, it is unclear to one of ordinary skill how certain actions such as the "sending" or "receiving" steps that are to be performed when successive transaction processes are processed, can be performed if the successive transaction processes are not necessarily processed.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 61 and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Hurvig (US Patent No. 5,678,007).

21. Regarding claim 61, Hurvig discloses a transaction processing method of using in a terminal device that obtains, from a server device, information for using a content based on a plurality of transaction processes and controls use of the content based on the obtained information, each of the plurality of transaction processes respectively

including a process of sending a request message from the terminal device, a process of receiving a response message, from the server device, and a process of sending, from the terminal device, a commit message for finalizing a completion of one transaction process (Hurvig **3:9-18**; **5:1-11**; **6:4-15**), wherein said terminal device includes a processor (Hurvig **7:32-41**).

The remaining limitations of claims 61 and 64 are directed toward software stored in the system. As the claim is directed towards the software "units" as components of the system, rather the functionality performed by the software when executed by the processor, these limitations are directed towards nonfunctional descriptive material and thus do not serve to differentiate the claims from the prior art. It has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

22. Claim 73 is rejected under 35 U.S.C. 102(b) as being anticipated by Moore, et al. (US Patent No. 5,732,266, hereinafter "Moore").

23. Regarding claim 73, Moore discloses a computer-readable recording medium having a program recorded thereon (Moore Abstract, **1:48-60**; **3:65-4:12**).

The remaining limitations are directed towards a program stored in the computer-readable medium. However, as the claim recites the program stored on the medium, as opposed to requiring that the program be executed to cause the computer or a processor to perform certain actions, the limitations directed to the program are nonfunctional descriptive material and thus do not serve to differentiate the claims from the prior art. It has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

25. Claims 61, 64, 70 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurvig in view of Bortvedt, et al (US Patent No. 5,799,305, hereinafter "Bortvedt").

26. Regarding claims 61, 70, and 73, Hurvig discloses a transaction processing method of using in a terminal device that obtains, from a server device, information for

using a content based on a plurality of transaction processes and controls use of the content based on the obtained information, each of the plurality of transaction processes respectively including a process of sending a request message from the terminal device, a process of receiving a response message, from the server device, and a process of sending, from the terminal device, a commit message for finalizing a completion of one transaction process (Hurvig **3:9-18**; **5:1-11**; **6:4-15**), wherein said terminal device includes a processor (Hurvig **7:32-41**) and said method includes:

- storing a transaction flag, in a memory of a holding unit, that corresponds to a transaction process of the plurality of transaction processes that is currently being processed and has a value of 0 or 1(Hurvig **6:4-7**, **6:54-7:9**; **10:1-14**);
- sending, by a sending unit, a plurality of request messages including the request message, when successive transaction processes of the plurality of transaction processes are processed (Hurvig **6:32-42**; **9:27-27**; **10:24-31**);
- receiving, by a response receiving unit, a plurality of response messages from the server device, when the successive transaction processes of the plurality of transaction processes are processed (Hurvig **6:43-53**; **10:34-45**);
- generating, by an inverting unit, a transaction flag having a value that is an inverse of a value of a previous transaction flag and updating, by an updating unit, the transaction flag stored in the memory of said holding unit to the transaction flag generated by said generating of the transaction flag (Hurvig **6:61-7:9**; **10:45-11:32**);

- performing a control so that, when said receiving of the plurality of response messages receives a response message from the server device without an occurrence of a communication error and in response to the previously sent request message, a request message is sent in a second or a following transaction process, other than a first transaction process, out of the successive transaction processes, and said performing of the control excluding a sending of a commit message along with the request message sent according to said performing of the control (Hurvig **5:45-51**; **8:9-29**).

Hurvig does not specifically disclose that the request messages include a transaction flag. Hurvig also does not specifically disclose sending a commit message in a last transaction process.

Bortvedt discloses including a transaction flag in a message (Bortvedt **15:5-23**; **15:66-16:8**) as well as sending a commit message in a last transaction process (Bortvedt Abstract; **4:12-35**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Hurvig to include providing a transaction flag in a message as well as sending a commit message as disclosed in Bortvedt in order to allow for efficient commitment in a distributed transaction (Bortvedt **3:56-4:3**; **4:13-35**).

27. Regarding claim 64 Hurvig discloses that said sending unit is configured to: send a request message, for a next transaction process, when a response message is

received by said response receiving unit without an occurrence of a communication error (Hurvig **5:45-51**; **8:9-29**); and

send again a request message, for the current transaction process, when a response message is not received by said response receiving unit without an occurrence of a communication error (Hurvig **9:32-37**; **11:33-37**).

Hurvig further discloses inverting a transaction flag when a response is received, and keeping the flag set while a response has not been received (Hurvig **7:4-9**).

Bortvedt discloses including a transaction flag in a request message (Bortvedt **15:5-23**; **15:66-16:8**).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Nilforoush whose telephone number is (571)270-5298. The examiner can normally be reached on Monday-Thursday 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A. N./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685